

REMARKS

By this Amendment, claims 1, 22, 36, 49, 54, 61, and 62 have been amended, and claims 55 and 65 have been cancelled. Each of the amendments is fully supported by the originally filed application, thus, no new matter has been added by this Amendment.

In the Office Action, claims 49, 50, 52-54, and 57-59 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,794,459 to Ignatowski ("Ignatowski"), claims 22, 28-34, 46, 51, 55, 56, and 65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ignatowski in view of U.S. Patent No. Des. 175,510 to Katz ("Katz"), and claims 1-3, 6, 8, 9, 14, 17, 36-42, 45, 47-54, and 56-62 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,095,587 to Ishikawa ("Ishikawa").

Applicants respectfully traverse the rejection of independent claims 49 and 54 as based on Ignatowski. As currently amended, claims 49 and 54 recite, among other things, a proximal end-piece positioned at a proximal-most end of a device and a distal end-piece positioned at a distal-most end of said device, the end-pieces being substantially spherical in shape. The amended claim features are supported throughout the application and at least at page 7, paragraph 38, and by original FIGS. 1, 2, 7, and 8.

Ignatowski, however, does not disclose or suggest a proximal end-piece positioned at a proximal-most end of a device, a distal end-piece positioned at a distal-most end of said device, the end-pieces being substantially spherical in shape. Instead, as illustrated in, for example, Figures 1 and 2, Ignatowski teaches a jewelry article 10 having a gripping member 20. The gripping member 20 “includes a main body 21 which cinches the ends of an elastic cord material 22 to form an elastic loop 23 extending upwardly from the main body 21. The gripping member 20 also includes a small loop 25 which is preferably formed of a malleable metal extending downwardly from the main body 21.” (Ignatowski, col. 4, ll. 50-55.)

Even assuming arguendo that the gripping member 20 could be construed as being positioned at a proximal-most end or at a distal-most end of the device (which Applicants do not necessarily concede), neither the elastic loop 23 considered in isolation (as being positioned at a distal-most end or a proximal-most end of the device), nor the gripping member 20 considered as a unit (and including the elastic loop 23 and the small loop 25), is substantially spherical in shape, as required by claims 49 and 54. Instead, as shown in at least Figures 2 and 3A-3E, the elastic loop 23 is substantially horseshoe-shaped and is configured to receive a temple arm 12 of an eyeglass frame 11. (See Ignatowski, col. 4, ll. 31-35.) Moreover, the unitary gripping member 20 includes the horseshoe-shaped elastic loop 23 at one end and the small loop 25 at

another end. Accordingly, Applicants request withdrawal of this rejection and allowance of claims 49 and 54.

Claims 50-53 depend directly or indirectly from independent claim 49, and claims 56-59 depend directly or indirectly from claim 54. Thus, each of these dependent claims is allowable for at least the same reasons stated above with regard to claims 49 and 54. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and, therefore, each is also separately patentable.

Applicants also respectfully traverse the rejection of independent claim 22 based on Ignatowski in view of Katz. As currently amended, claim 22 recites, among other things, a proximal end-piece positioned at a proximal-most end of a device and a distal end-piece positioned at a distal-most end of said device, the end-pieces being substantially spherical in shape. The amended claim features are supported at least at page 7, paragraph 38 of the application and by original FIGS. 1, 2, 7, and 8.

Ignatowski, however, does not disclose or suggest these claimed features. Instead, as discussed above, Ignatowski teaches a gripping member 20 having a horseshoe-shaped elastic loop 23 at one end and a small loop 25 at another end. Neither the elastic loop 23 considered in isolation, nor the gripping member 20 considered as a unit, is substantially spherical in shape as required by claim 22.

Katz does not cure these deficiencies. Instead, Katz teaches a necklace or the like, including, what appears to be, two bulbous structures disposed at a first end of the device. Even assuming *arguendo* that the bulbous structures of Katz could be construed as being substantially spherical in shape (which Applicants do not necessarily concede), Applicants disagree with the assertion in the Office Action that, it “would have been obvious to have made the end pieces of Ignatowski spherical, as merely an obvious design choice for the purposes of providing a known ornamentation to the chain.” (Office Action, p. 3, ll. 16-18.) As explained in Ignatowski, the combination of “the gripping member 20 and the securely attached elongated decorative strands 30 forms a unitary jewelry item which is designed to be changed only as a unit, e.g. by being slid on and off of the temple arm 12 of the eyeglass frame 11.” (Ignatowski, col. 5, ll. 36-41.) A “preferred form for the gripping member 20 is a prefabricated eyeglass holder, which is manufactured with a closed eye-loop depending from the main body.” (Ignatowski, col. 5, ll. 44-46.) “Gripping members 20 of this general type have been known to be used in pairs to form retaining necklaces for eyeglasses 11.” (Ignatowski, col. 4, ll. 63-65.) Thus, an object of the Ignatowski design is to provide a jewelry article that is “particularly adapted for use with an eyeglass frame,” and the gripping member 20 of Ignatowski is specifically employed for this function. (Ignatowski, col. 1, ll. 54-55.) Replacing, for example, either the elastic loop 25 or the unitary gripping member 20 (including the main body 21 and the small loop 25) of Ignatowski with the bulbous

structure of Katz would destroy the functionality of the Ignatowski device. In particular, the bulbous structure of Katz is not capable of receiving or otherwise connecting to a temple arm 12 of an eyeglass frame 11, nor does the Office Action indicate how any such connection would be possible. Accordingly, replacing the gripping member 20 of Ignatowski with the bulbous structure of Katz would not have been an obvious design choice, nor would one skilled in the art have arrived at the claimed device after considering the scope and content of Ignatowski and Katz. Reconsideration is respectfully requested.

Claims 15, 28-34 and 46 depend directly or indirectly from claim 22. Thus, each of these dependent claims is allowable for at least the same reasons stated above with regard to claim 22. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and, therefore, each is also separately patentable.

Applicants also respectfully traverse the rejection of independent claims 1, 36, 49, 54, 60, 61, and 62 based on Ishikawa. As currently amended, claims 1, 36, 61, and 62 require, among other things, a proximal end-piece positioned at a proximal-most end of a device and a distal end-piece positioned at a distal end of said device, the end-pieces having substantially the same non-looped shape. The amended claim features are supported at least at page 7, paragraph 38 of the application and by original FIGS. 1, 2, 7, and 8.

Ishikawa, however, does not disclose or suggest these claim features. Instead, Ishikawa teaches a magnetic ornament “provided with connections 9 and 9’ at its ends.” (Ishikawa, col. 2, ll. 56-57.) As shown in Figure 5, the first connection 9 is substantially C-shaped and includes a discontinuous or open portion. The first connection 9 also includes, what appears to be, a protrusion proximate the open portion. The second connection 9’, on the other hand, has a substantially trapezoidal shape with rounded edges. Other than the illustration of Figure 5, Ishikawa provides no further description of the connections 9, 9’. Ishikawa, therefore, does not disclose or suggest, among other things, end-pieces having substantially the same non-looped shape, as recited in independent claims 1, 36, 61, and 62.

Moreover, it would not have been obvious to replace the connections 9, 9’ with end-pieces having substantially the same non-looped shape. The connections 9, 9’ are employed to accomplish the function of connecting a first end of the device to a second end of the device such that it may be worn by the user, and replacing the connections 9, 9’ with end-pieces having substantially the same non-looped shape, as recited in claims 1, 36, 61, and 62, would render the Ishikawa device unsuitable for its stated purpose. In particular, end-pieces having substantially the same non-looped shape are less suitable for connecting first and second ends of devices such as those taught by Ishikawa, nor does the Office Action indicate how any such connection would be possible. Accordingly, replacing the connections 9, 9’ of Ishikawa with end-pieces having

substantially the same non-looped shape as recited in amended independent claims 1, 36, 61, and 62 would not have been an obvious design choice, nor would one skilled in the art have arrived at the claimed device after considering the scope and content of Ishikawa.

Furthermore, as discussed above, claims 49 and 54 require, among other things, a proximal end-piece positioned at a proximal-most end of a device and a distal end-piece positioned at a distal-most end of said device, the end-pieces being substantially spherical in shape. Ishikawa, however, does not disclose or suggest these features, nor would it have been obvious to replace the connections 9, 9' of Ishikawa with end-pieces that are substantially spherical in shape. In particular, end-pieces that are substantially spherical in shape are less suitable for connecting first and second ends of devices such as those taught by Ishikawa, nor does the Office Action indicate how any such connection would be possible. Accordingly, replacing the connections 9, 9' of Ishikawa with end-pieces that are substantially spherical in shape as recited in amended independent claims 49 and 54 would hinder the functionality of the resulting device.

Although independent claim 60 was rejected in view of Ishikawa, the Office Action gives no citation to any teaching in Ishikawa of at least, for example, a member of each loop being biodegradable, as recited in claim 60. Nor does the Office Action indicate how at least this claim limitation would have been obvious in view of Ishikawa. To the contrary, it would not have been obvious for one skilled in the art of magnetic

ornaments to modify each loop of Ishikawa to be, for example, biodegradable.

Reconsideration is respectfully requested.

Claims 2-12, 14, 15, 17-20, 23, 45, 48, and 63 depend directly or indirectly from independent claim 1, claims 37-42, 47, and 64 depend directly or indirectly from independent claim 36, claims 50-53 depend directly or indirectly from independent claim 49, and claims 56-59 depend directly or indirectly from claim 54. Thus, each of these dependent claims is allowable for at least the same reasons stated above with regard to claims 1, 36, 49, and 54. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and, therefore, each is also separately patentable. Though some of these dependent claims have been withdrawn, Applicants request consideration of the withdrawn claims based on the allowability of claims 1, 36, 49, and 54.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the final Office Action.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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